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### Remarks

Reconsideration of the above-captioned application is respectfully requested. Claims 1-4 have been rejected as being anticipated by Jaster, and Claims 1-32 have been rejected as being obvious over DeBlock et al. alone or in combination with Jaster.

To overcome the anticipation rejection, Claim 1 has been amended to recite that the shaft is not transparent as supported on, e.g., page 6, penultimate paragraph (disclosing that the shaft may be metal). New dependent Claims 33-39, directed to the embodiment shown in Figure 3d, have been added. Claims 1-39 remain pending.

### Rejections Under 35 U.S.C. §102

Claims 1-4 have been rejected under 35 U.S.C. §102 as being anticipated by Jaster, which teaches a transparent dome having a conical transparent reflector therein. Jaster does not disclose anything about what is below the base 14 of its roof-mounted dome, i.e., Jaster does not even show the shaft to which the dome is attached.

Nonetheless, the examiner has confused the dome of Jaster with a skylight shaft. It is not. To make this distinction even more explicit, Claim 1 now requires that the shaft on which the film is adhered (and which bears the surface irregularity) is not transparent. Clearly, the dome structure of Jaster that has been relied on as a teaching of Claim 1 cannot be anything but transparent, or Jaster wouldn't have much of a skylight left. Since, to support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §2131, this rejection is overcome.

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**Rejections Under 35 U.S.C. §103**

Claims 5, 6, 10, and 14-26 have been rejected under 35 U.S.C. §103 as being unpatentable over DeBlock et al., and Claims 1-4, 7-9, 11-13, and 27-32 have been rejected as being unpatentable over DeBlock et al. in view of Jaster. As admitted by the examiner, "DeBlock et al. does not disclose expressly at least one surface irregularity formed on at least one of: the adhesive, the reflective film, and the shaft."

While Applicant agrees with this admission, he notes that the examiner has somewhat confusingly characterized the elements 72, 74 in DeBlock et al. as being "surface irregularities", which manifestly they are not. According to DeBlock et al. elements 72 and 74 are simply the inner and outer surfaces of an apparently smooth dome. Accordingly, Applicant will focus prosecution on the correct admission by the Examiner that DeBlock et al. has no surface irregularity formed in at least one of: the adhesive, the reflective film, and the shaft.

To remedy the admitted shortfall of DeBlock et al., the examiner proposes to combine DeBlock et al. with Jaster, alleging that the reflector 80 of Jaster would establish the claimed surface irregularities, because Jaster teaches that the reflector 80 can be formed by laminating together triangular-shaped sections. This argument is hazy at best, because the reflector 80 after lamination is conical shaped. To the extent that any surface irregularities exist in Jaster it is the prism portions 90 in the reflector 80. But it doesn't matter. Combining DeBlock et al. with Jaster would result only in DeBlock et al. having Jaster's transparent dome with upside-down conical reflector therein. To the extent that the proposed combination would have any surface irregularities, they would not be in the shaft, or adhesive, or film as required in, e.g., Claim 1, but rather in the Jaster dome that covers the DeBlock et al. shaft. Because MPEP §§2142 and 2143.03 require that, to establish a prima facie case of obviousness, an examiner must explain where in the prior art all of

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the claimed limitations are taught or suggested, the present rejection, which fails to establish surface irregularities as set forth in Claim 1, is legally deficient and should be withdrawn.

For the reasons advanced above, it is believed that Claim 11 is patentable over the relied-upon references. Moreover, it is asserted that Claims 14 and 19, which require forming surface irregularities in a substrate that is subsequently formed into a shaft, is patentable over the relied-upon references, which nowhere show surface irregularities in a shaft. Likewise, Claim 23, which requires forming the surface irregularities in an adhesive that is disposed on a substrate that is subsequently formed into a shaft is patentable. The remaining claims, none of which have been specifically addressed in the Office Action, are patentable as well.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (amended) A skylight assembly, comprising:
  - at least one skylight shaft;
  - at least one layer of reflective film on the inside of the shaft;
  - at least one layer of adhesive holding the film to the shaft; and
  - at least one surface irregularity formed in at least one of: the adhesive, the reflective film,and the shaft;  
wherein the shaft is not transparent.

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